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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/415,957	10/08/1999	SHLOMO KIPNIS	U013174-6	5512

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EXAMINER

DINH, MINH

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/415,957

Applicant(s)

KIPNIS ET AL.

Examiner

Minh Dinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19, 33 and 35-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19, 33 and 35-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/08/1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 8 and 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### DETAILED ACTION

1. Claims 1-19, 33 and 35-41 have been examined.

#### ***Claim Rejections - 35 USC § 112***

2. Claims 1, 33 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 33 and 38 recite the limitation "the communication network" in lines 11, 12 and 12 respectively. There is insufficient antecedent basis for this limitation in the claims.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-6, 9-10, 12, 15-16, 19, 33, 36, 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiGiorgio et al., U.S. Patent No. 6,385,729 in view of Tolopka et al., U.S. Patent No. 6,044,349.

- a. Referring to claim 1, DiGiorgio discloses a method for remote administration of a smart card via communication network comprising the steps of:

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associating a smart card with a remote administrator by storing administrator identification of the remote administrator in the smart card (col. 10, lines 58-60);

inserting a smart card in a user unit (col. 9, lines 49-50);

establishing communication between the smart card and a remote administrator via a communication network (col. 10, lines 25-26).

DiGiorgio does not disclose the step of employing the administrator identification information stored in the smart card to identify and establish communication with the remote administrator. Tolopka discloses the step of employing the administrator identification information stored in the smart card to identify and establish communication with the remote administrator (col. 5, lines 9-11; col. 6, lines 21-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of DiGiorgio such that identification information of a remote administrator is used to identify and establish communication with the remote administrator, as taught by Tolopka. That way the user unit can be dynamically configured to establish communication with different remote administrators.

b. Referring to claim 2, DiGiorgio further discloses that communication with the remote administrator is performed by the user unit (col. 5, lines 50-51; col. 10, lines 25-26).

c. Referring to claim 3, DiGiorgio further discloses communication with the remote administrator employing the Internet Protocol (col. 5, lines 52-53).

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d. Referring to claim 5, DiGiorgio further discloses the step of administrating the smart card after communication with the remote administrator is established (col. 10, lines 29-30).

e. Referring to claim 6, DiGiorgio further discloses the step of administrating the smart card immediately after communication with the remote administrator is established (col. 10, lines 29-30).

f. Referring to claim 9, DiGiorgio further discloses the step of performing an administration initialization procedure to authenticate the smart card (col. 10, lines 30-47).

g. Referring to claim 10, DiGiorgio further discloses the step of preventing performance of any operation other than the administration initialization procedure until the procedure is verified to be in order (col. 10, lines 47-50).

h. Referring to claim 12, DiGiorgio further discloses the step of accessing a protected information resource (col. 10, lines 47-48).

i. Referring to claims 15 and 16, DiGiorgio further discloses the step of performing security mechanisms, bilateral authentication, for accessing the protected information resource by the smart card (col. 10, lines 28-48).

j. Referring to claim 19, DiGiorgio further discloses that the communication network comprises a MAN or a WAN (col. 5, lines 53-55).

k. Claim 33 is rejected on the same basis as claim 1.

l. Referring to claim 36, DiGiorgio further discloses protected information resource accessible by the smart card via the remote administrator (col. 10, lines 24-25).

m. Claim 38 is rejected on the same basis as claim 1.

n. Claim 40 is rejected on the same basis as claim 12.

5. Claims 4 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiGiorgio et al. in view of Tolopka et al. as applied to claim 1 above, and further in view of Hudson et al., U.S. Patent No. 6,055,637.

a. Referring to claim 4, DiGiorgio and Tolopka do not teach the use of a local administrator and the steps of identifying the local administrator and determining the local administrator as a proxy administrator. Hudson teaches the use of a local administrator and the step of identifying the local administrator (col. 4, lines 50-55) and determining the local administrator as a proxy administrator (col. 4, lines 55-58). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of DiGiorgio and Tolopka to include a local administrator and the steps of identifying the local administrator and determining the local administrator as a proxy administrator, as taught by Hudson, to reduce loads at the remote administrator and thus to increase performance.

b. Referring to claim 7, DiGiorgio and Tolopka disclose the step of administering the smart card after communication with the remote administrator is established (col. 10, lines 29-30). DiGiorgio and Tolopka do not teach the use of a

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proxy administrator. Hudson teaches the use of a proxy administrator (col. 4, lines 55-58). Please refer to motivation recited for using a proxy administrator as taught by Hudson in claim 4.

c. Referring to claim 8, DiGiorgio and Tolopka disclose the step of administering the smart card immediately after communication with the remote administrator is established (col. 10, lines 29-30). DiGiorgio and Tolopka do not teach the use of a proxy administrator. Hudson teaches the use of a proxy administrator (col. 4, lines 55-58). Please refer to motivation recited for using a proxy administrator as taught by Hudson in claim 4.

6. Claims 11, 18, 35, 37, 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiGiorgio et al. in view of Tolopka et al. as applied to claims 1, 33 and 38 above, and further in view of Murphy et al., U.S. Patent No. 6,266,744.

a. Referring to claims 11, 35 and 39, DiGiorgio and Tolopka do not disclose a smart card database at the remote administrator and the step of identifying the smart card in the smart card database. Murphy discloses a smart card database at the remote administrator and the step of identifying the smart card in the smart card database (col. 6, lines 33-39). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of DiGiorgio and Tolopka to include a smart card database at the remote administrator and the step of identifying the smart card in a smart card database, as taught by Murphy, so that information for

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identification of smart cards can be easily stored and utilized by the remote administrator.

b. Referring to claims 18, 37 and 41, DiGiorgio and Tolopka do not disclose that the remote administrator comprises a plurality of administrator. Murphy discloses that a remote administrator can comprise a plurality of administrators (col. 5, lines 39-49). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of DiGiorgio and Tolopka such that the remote administrator comprises a plurality of administrator, as taught by Murphy, to have a flexible implementation of the remote administrator.

7. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiGiorgio et al. in view of Tolopka et al. as applied to claim 12 above, and further in view of Muftic, U.S. Patent No. 5,943,423. DiGiorgio and Tolopka do not disclose the step of performing an administration operation. Muftic discloses the step of performing an administration operation by transmitting a certificate and credentials (col. 5, lines 33-38). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of DiGiorgio and Tolopka to include the step of performing an administration operation by transmitting a certificate and credentials, as taught by Muftic, in order for the remote administrator to be able to control access to the protected resources.



8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over DiGiorgio et al. in view of Tolopka et al. as applied to claim 12 above, and further in view of Pare, Jr. et al., U.S. Patent No. 5,838,812. DiGiorgio and Tolopka disclose that each operation performed during the accessing step by the smart card is performed only at the end of an administration procedure (col. 10, lines 47-50). DiGiorgio and Tolopka do not teach the use of an "END ADMINISTRATION OPERATION" message at the end of a two-way authentication. Pare, Jr. teaches the use of message presented at the end of each operation, which has the same function as the "END ADMINISTRATION OPERATION" message (col. 6, lines 48-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of DiGiorgio and Tolopka to present a message at the end of an administration procedure, as taught by Pare, Jr., so that users can be informed of the result of the operation.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sher, U.S. Patent No. 6,325,292, discloses a card system and method utilizing collector cards.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 703-306-5617.

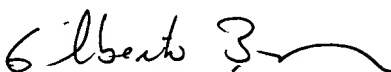
The examiner can normally be reached on Mon - Fri: 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.

Minh Dinh  
Examiner  
Art Unit 2132

md  
November 26, 2003

  
GILBERTO BARRON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100